

REMARKS

The present Amendment is submitted in response to the final Office Action mailed November 23, 2005.

The disclosure is directed to a surgical needle having a varied taper point profile. Specifically, the taper point profile of the needle has a varied taper angle defining a smaller taper ratio in a first region adjacent the tip of the needle relative to a second region proximal of the first region. This varied taper point profile arrangement, in turn, provides an enlarged needle end relative to conventional taper point needles, which is more resistant to breakage during use in a surgical procedure such as an ophthalmic surgery, while providing sufficient penetration performance. Moreover, even in view of its enlarged character or profile, the nature of the varied tapered regions permits unexpected ease of passage of the needle through tissue.

Claims 1-12 stand rejected under 35 USC §103(a) over U.S. Patent No. 5,913,422 to Smith and U.S. Patent No. 5,464,422 to Silverman and claims 1-12 stand rejected under 35 U.S.C. §103(a) over Smith '422. Smith '875 discloses a taper point needle having three tapered regions of significantly large tapers. The resulting needle end of Smith '875 is relatively narrow. Silverman '422 is directed to a surgical needle having a shaft portion, a tip portion 13, a conical point portion 15 and a point 17. The tip portion 13 of Silverman '422 includes a constant or linear taper.

It is respectfully submitted that the claimed surgical needle is patentably distinguishable over the combination of these two disclosures. As discussed, the cited references

do not disclose surgical needles having variable taper regions as recited in each of independent claims 1, 3 and 10. These taper regions define a relatively large needle end compared to conventional surgical needles. Moreover, by virtue of varying the taper ratios of adjacent regions coupled with decreased relative ratio values, Applicants have developed a new and novel surgical needle which is superior to conventional designs and which provides unexpected results with respect to needle passage, e.g., less drag through tissue.

In addition, the Office Action fails to point to any specific teachings in the references which meet the critical taper ratios defined in the claims. Rather, the Office Action relies on the following statement as a “teaching” that the taper ratios of needle can be adjusted to have desired results:

“Those skilled in the art will appreciate that the length of the tapered segment 100, as well as tapered segments 120 and 140, will vary in accordance with the size of the needle wire used, the strength and penetration resistance characteristics desired (i.e., tissue piercing, resistance to bending, ease of penetration and the like) - 3:43-4:22 of Smith ‘875.”

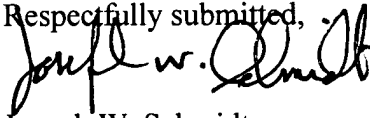
However, this passage is directed to altering the “lengths” of the tapered segments not the values of taper ratios, particularly, not within the manner recited in the independent claims.

Accordingly, in that none of the references teach the arrangement and values for the taper ratios recited in the claims, amongst other distinctions, it is respectfully submitted that the Patent Office has failed to meet its case of prima facie obviousness See In re Bell, 991 F.2d 781 (Fed. Cir. 1993) (“The PTO bears the burden of establishing a case of prima facie obviousness”). Accordingly, the rejections are improper. Withdrawal of the rejections is respectfully requested.

[X] A Notice of Appeal is being submitted herewith.

It is respectfully submitted that none of the references of record disclose or suggest the claimed invention, regardless of whether the references are considered individually or in combination, with themselves, considered in whole or in part. Accordingly, withdrawal of the rejections is respectfully requested.

In view of the foregoing amendments and remarks, reconsideration of the rejections and objections and allowance of the claims are earnestly solicited.

Respectfully submitted,

Joseph W. Schmidt
Reg. No. 36,920
Attorney for Applicant(s)

CARTER, DELUCA, FARRELL & SCHMIDT, LLP
445 Broad Hollow Road, Suite 225
Melville, New York 11747
Telephone: (631) 501-5700
Facsimile: (631) 501-3526

JWS/td